The opinion in support of the decision being entered today was
not written for publication and is **not** binding precedent of the
Board.

Paper No. 37
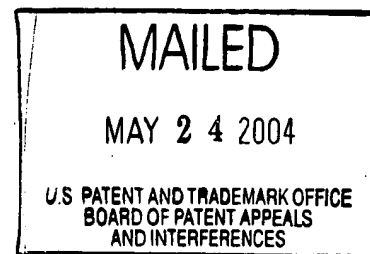
UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte JOHN TANG, CHRIS RYAN, TREVOR MORRIS
and ELLEN ISAACS

_____

Appeal No. 2002-0787
Application 08/885,597

_____

ON BRIEF

_____

Before BARRETT, FLEMING, and BLANKENSHIP, **Administrative Patent
Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from claims that have been
twice rejected. Claims 1 through 32 are all of the claims that
are pending in the instant application and are subject to this
appeal.

1

Invention

The invention relates to the animation of icons on a computer display. See page 1 of Appellants' specification. A software container is a representation of one or more objects. An object is an entity, such as a program, that has state and functionality. An animated indicator displays a graphical animation on the computer screen that represents a software container. Animated indicators graphically reflect the state of the container, potentially including information such as amount, type, and activity of the container. See page 4 of Appellants' specification.

Figure 1 is a block diagram of an exemplary computer system to display animated indicators. Computer system 100 includes a processor 102 and a memory 104 coupled to a processor 102 through a bus 106. See page 5 of Appellants' specification.

Figure 2 is a high level diagram showing the general software organization of computer system 100 according to the Appellants' invention. System software 202 interfaces application programs, such as container 204 and animated indicator program 206, with the hardware of computer system 100.

Animated indicator program 206 controls the animation sequence of the animated indicators. Monitoring program 208 watches container 204 and informs animation program 206 of pertinent changes in the state of the objects in container 204. In response to changes indicated by monitor 208, animated indicator program 206 may accordingly modify animation. See page 6 of Appellants' specification.

Figure 3 is a flowchart showing the logical flow of animated indicator program 206 according to Appellants' invention. The display of a particular animated indicator is initiated by a user action such as minimizing a container (step 301). Animated indicator program 206, through monitor program 208, examines container 204 and determines whether its state has changed enough to warrant a revised animated cycle (steps 302 and 304). If so, the animated indicator program causes the animated indicators to undergo a new animation cycle (i.e., a series of frames serially displayed and cycled to create animation) (step 306) and displays the cycle (step 308). See pages 6 and 7 of Appellants' specification.

Independent claim 1 present in the application is representative of Appellants' claimed invention and is reproduced as follows:

1. A process for reflecting a state of a software container having objects, comprising:

cyclically displaying a series of frames reflecting a state of the container as an animated sequence;

detecting an event reflecting a change in the state of the container;

determining based on the detected event whether an animated sequence does not reflect the state of the container; and

updating the cyclical display based on the determination.

References

The references relied on by the Examiner are as follow:

Baecker et al. (Baecker)	5,479,602	Dec. 26,	1995
Gudmundson et al. (Gudmundson)	5,680,619	Oct. 21,	1997
Lagarde et al. (Lagarde)	5,721,908	Feb. 24,	1998
	(Filing date June	7,	1995)
Johnston Jr. et al. (Johnston)	5,880,729	Mar. 9,	1999
	(Filing date May	5,	1995)
Nguyen	5,978,840	Nov. 2,	1999
	(Filing date Sept. 26,		1996)

Gallagher (ed.), Computer Visualization - Graphics Techniques For Scientific and Engineering Analysis, 206-07, 220-27 (1995)

STN Express, Copyright 1996

Rejections at Issue

Claims 1, 13, 29, 31 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Baecker in view of Johnston. Claims 2 through 4, 10, 14, and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Baecker and Johnston in view of Gudmundson. Claims 5, 6, 9, 11, 12, 15, 17, and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Baecker, Johnston, Gudmundson and further in view of Gallagher. Claims 7, 19 through 21, 25, and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnston. Claims 22 through 24, and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over STN Express, Johnston, and further in view of Nguyen. Claims 27 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Baecker, Lagarde, and further in view of STN Express and Johnston. Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Johnston and further in view of Gallagher.

Throughout our opinion, we make references to the briefs[1]

and answer for the respective details thereof.

OPINION

With full consideration being given to the subject matter on

appeal, the Examiner's rejections and the arguments of the

Appellants and the Examiner, for the reasons stated **infra**, we

reverse the Examiner's rejection of claims 1 through 32 under

35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the Examiner

bears the initial burden of establishing a **prima facie** case of

obviousness. **In re Oetiker,** 977 F.2d 1443, 1445, 24 USPQ2d 1443,

1444 (Fed. Cir. 1992). **See also In re Piasecki,** 745 F.2d 1468,

1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can

satisfy this burden by showing that some objective teaching in

the prior art or knowledge generally available to one of ordinary

skill in the art suggests the claimed subject matter. **In re**

Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

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[1] Appellants filed an appeal brief on September 17, 2001.
Appellants filed a reply brief on January 7, 2002. The Examiner
mailed out an office communication, paper no. 35, stating that
the reply brief has been entered and considered.

Only if this initial burden is met does the burden of coming

forward with evidence or argument shift to the Appellants.

Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**,

745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and

consideration of all the pertinent evidence and arguments. "In

reviewing the [E]xaminer's decision on appeal, the Board must

necessarily weigh all of the evidence and argument." **Oetiker**,

977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only

assure that the requisite findings are made, based on evidence of

record, but must also explain the reasoning by which the findings

are deemed to support the agency's conclusion." **In re Lee**, 277

F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). With

these principles in mind, we commence review of the pertinent

evidence and arguments of Appellants and Examiner.

Rejections of Claims 1 through 6, 13 through 18, 29, 31, and 32

Claims 1, 13, 29, 31 and 32 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Baecker in view of Johnston.

Appellants argue that Baecker or Johnston do not teach or suggest

detecting an event reflecting a change in the state of the

container and determining based on the detected event whether an

7

animated sequence does not reflect the state of the container.

See pages 8 through 12 of the brief and the reply brief. We note

that Appellants' claim 1 recites:

> detecting an event reflecting a change in the state of the
> container; determining based on the detected event whether
> an animated sequence does not reflect the state of the
> container.

Claim 13 recites the same language. Claim 32 recites:

> detecting an event reflecting a change in the state of the
> container, wherein the container is a web page related to
> user discussion; determining based on the detected event
> whether an animated sequence does not reflect the state of
> the container.

The Examiner states that Baecker discloses a processor which

generates new animation frames whenever the file or folder

represents that the icon changes. The Examiner points us to

Baecker, column 8, lines 58 through 67. The Examiner relies on

Johnston for teaching detecting an event reflecting a change in

the state of the container. The Examiner points us to column 2,

lines 40 through 50. See pages 3 and 4 of the Examiner's answer.

8

Upon our review of Baecker, we agree that Baecker teaches a

process which generates a new animation frame whenever the file

or folder represented by the icon changes. See Baecker column 7,

line 30, through column 8, line 67. However, we fail to find

that Baecker teaches determining based upon a detected event

whether an animated sequence does not reflect the state of the

container as recited in Appellants' claims. Furthermore, we fail

to find that Johnston teaches this limitation as well. Johnston

teaches an animated effect that can be created by repeatedly

redrawing a control element using stored transitional images

after a control element has been actuated by the user. See

Johnston, column 2, lines 40 through 50. Johnston teaches that

figure 5 provides an example of this concept therein, the same

rendering entitled `find" is displayed by graphic user interface

on a display 30. To the right of the find window 31 in figure 5

is a rectangle which contains an exemplary display. A first

static display state 32 is shown which corresponds to the normal

display state of the find button before a user activates the

button. After the user activates the find button, the user

interface enters a routine for providing a transitional effect on

the display 30. The transitional effect is an animated sequence

which gives the visual impression of flipping the find button around an axis. See Johnston, column 3, line 65, through column 4, line 20. Although Johnston does teach animating control elements to transition between the states, we fail to find that Johnston teaches a system for determining based on a detected event whether an animated sequence does not reflect the state of the container as recited in Appellants' claims. Therefore, we will not sustain the Examiner's rejection of claims 1, 13, 29, 31, and 32 under 35 U.S.C. § 103 as being unpatentable over Baecker in view of Johnston.

Claims 2 through 6 are dependent upon claim 1 and claims 14 through 18, and 31 are dependent on claim 13. Thus, these claims recite the above limitation. Claims 2 through 4, 14, and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Baecker and Johnston in view of Gudmundson. Upon our review of Gudmundson, we fail to find that Gudmundson teaches a system for determining based upon a detected event whether an animated sequence does not reflect the state of the container. Therefore, we will not sustain this rejection for the same reasons as above.

Claims 5, 6, 15, 17, and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Baecker, Johnston, Gudmundson and further in view of Gallagher. Upon our review of Gallagher, we fail to find that Gallagher teaches a system for determining based upon a detected event whether an animated sequence does not reflect the state of the container. Therefore, we will not sustain this rejection for the same reasons as above as well.

Rejection of Claims 7 through 12, 19 through 21, 25, and 30

Claims 7, 19 through 21, 25, and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnston. We note that claims 7 and 30 recite:

> animated indicator program including computer code for monitoring the software container to detect an event reflecting a change in a state of the container, for determining based on the detected event whether an aminated sequence does not reflect the state of the container.

Furthermore, we have already found above that Johnston fails to teach the limitation of determining based upon a detected event whether an animated sequence does not reflect the state of the container. Therefore, we will not sustain this rejection for the same reasons as above.

Claims 19 and 25 recite:

detecting activity of the closed container; and updating an animated sequence so as to reflect activity of the closed container.

The Examiner states that it would be obvious to one of ordinary skill in the art to detect activity of the closed container and to update the animated sequence so as to reflect the activity of the closed container. See pages 11 and 12 of the answer.

When determining obviousness, "[t]he factual inquiry whether to combine references must be thorough and searching." **Lee,** 277 F.3d at 1343, 61 USPQ2d at 1433, **citing McGinley v. Franklin Sports, Inc.,** 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). "It must be based on objective evidence of record." **Id.** "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak,** 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Upon our review of Johnston, we fail to find that Johnston teaches or suggests detecting activity of a closed container or updating an animated sequence as to whether it will reflect the activity of a closed container. Furthermore, we fail to find that the Examiner has provided us with any evidence to support the Examiner's conclusion that it would have been obvious to provide these limitations. Therefore, we will not sustain the Examiner's rejection of claims 7, 19 through 21, 25 and 30 under 35 U.S.C. § 103 as being unpatentable over Johnston.

Claims 8 through 12 are directly or indirectly dependent on claim 7. Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Baecker, Johnston and further in view of Gudmundson. As we found above, these references fail to teach a system for determining based upon a detected event whether an animated sequence does not reflect the state of the container. Therefore, we will not sustain the rejection of claim 10 for the same reasons as above. Claims 9, 11, and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Baecker, Johnston, Gudmundson and Gallagher. We have found that these references also fail to teach the above limitation. Therefore, we will not sustain this rejection as well. Claim 8 stands rejected under

13

35 U.S.C. § 103 as being unpatentable over Johnston in view of

Gallagher. We have found that these references have not taught

or suggested determining based upon a detected event whether an

animated sequence does not reflect the state of the container.

Therefore, we will not sustain the rejection of claim 8 for the

same reasons as above.

Rejection of claims 22 through 24, 26, 27, and 28

Claims 22 through 24, and 26 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over STN Express in view of Johnston

and Nguyen. Claims 27 and 28 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Baecker, STN Express, Lagarde in

view of Johnston.

We note that claim 22 recites:

> detecting if a second computer system has acted upon the
> container; and updating an animated sequence to be displayed
> on the first computer system so as to reflect the actions of
> the second computer system.

We note that claim 26 recites the same language. The Examiner

states STN Express teaches a first computer acting upon a

software container in a second computer. The Examiner states

that Nguyen teaches networking on the Internet. The Examiner

further states that it is obvious to one of ordinary skill in the

14

art to detect if a second computer system has acted upon the container. See page 13 of the answer.

We fail to find that the Examiner has properly made a **prima facie** case of obviousness. The Examiner has not provided any evidence as to why one of ordinary skill in the art would provide a step of detecting if a second computer system has acted upon the container. In particular, we find that the references fail to teach or suggest detecting if a second computer system has acted upon a container and updating an animated sequence to be displayed on the first computer system so as to reflect the action of the second computer system. Therefore, we will not sustain the Examiner's rejection of claims 22 through 24, and 26 under 35 U.S.C. § 103.

Appellants' claim 27 recites:

code for performing a process for reflecting activity of a software container that is closed, including code for detecting activity of the closed container and code for updating an animated sequence so as to reflect activity of the closed container.

We fail to find that the Examiner has shown that Baecker, STN Express, Lagarde or Johnston teaches these limitations.

Appellants' claim 28 recites:

> code for detecting if a second computer system has acted
> upon the container, and code for updating an animated
> sequence to be displayed on the first computer system so as
> to reflect the actions of the second computer system.

We fail to find that the Examiner has shown that Baecker, STN

Express, Lagarde or Johnston teaches this limitation as well.

Therefore, we will not sustain the Examiner's rejection of claims

27 and 28 under 35 U.S.C. § 103.

NEW GROUND OF REJECTION

We make the following new ground of rejection for claims 19

through 28 under 35 U.S.C. § 112, first paragraph, for failure to

comply with the written description requirement.

The first paragraph of 35 U.S.C. § 112 requires that "the

specification shall contain the written description of the

invention[.]" 35 U.S.C. § 112, first paragraph (1994). This

requires the Appellants to "convey with reasonable clarity to

those skilled in the art that, as of the filing date sought, he

or she was in possession of the invention. The invention is, for

purposes of the 'written description' inquiry, whatever is now

claimed." **Vas-Cath, Inc. v. Mahurkar**, 935 F.2d 1555, 1563-64, 19

USPQ2d 1111, 1117 (Fed. Cir. 1991). Thus, the inquiry is "not a

16

question of whether one skilled in the art might be able to
construct the patentee's device from the teachings of the
disclosure. . . . Rather, it is a question whether the
application necessarily discloses that particular device."
Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41
USPQ2d 1961, 1966 (Fed. Cir. 1997), **citing Martin v. Mayer**, 823
F.2d 500, 504, 3 USPQ2d 1333, 1337 (Fed. Cir. 1987) (quoting
Jepson v. Coleman, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA
1963)).

An Applicant complies with the written description
requirement "by describing the invention, with all its claimed
limitations[.]" **Id.** "One does that by such descriptive means as
words, structures, figures, diagrams, formulas, etc., that fully
set forth the claimed invention." **Id.** "[T]he written
description must include all of the limitations . . . or the
applicant must show that any absent text is necessarily
comprehended in the description provided and would have been so
understood at the time the patent application was filed." **Hyatt
v. Boone**, 146 F.3d 1348, 1354-55, 47 USPQ2d 1128, 1132 (Fed. Cir.
1998).

Claims 19 through 21, 25, and 27 are directed to detecting
activity of a closed container and updating an animated sequence
so as to reflect activity of the closed container. However, this
subject matter is not supported in Appellants' specification or
drawings. We fail to find any mention of a process or computer
system for reflecting activity of a software container that is
closed. Furthermore, we fail to find any description of
detecting the activity of the closed container or updating an
animated sequence so as to reflect the activity of the closed
container.

Claims 22 through 24, 26 and 28 are directed to a process or
computer system for reflecting activity of a network-based
software container associated with a first computer system that
detects if a second computer system has acted upon the container
and updating an animated sequence to be displayed on the first
computer system so as to reflect the actions of the second
computer system. Upon our review of the Appellants'
specification and drawings, we fail to find support for this
subject matter. In particular, we fail to find any drawings or
mention in the specification of detecting if a second computer
system has acted upon a container as well as any description of

18

updating an animated sequence to display on the first computer

system so as to reflect the actions of the second computer

system. Therefore, we find that the Appellants have not conveyed

with reasonable clarity to one skilled in the art that they had

possession of the claimed invention recited in claims 19 through

28 as required under 35 U.S.C. § 112, first paragraph.

CONCLUSION

In view of the foregoing, the decision of the Examiner

rejecting claims 1 through 32 under 35 U.S.C. § 103 is reversed.

The decision contains a new ground of rejection pursuant to

37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule

notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off.

Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR

§ 1.196(b) provides that "[a] new ground of rejection shall not

be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN

TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of

the following two options with respect to the new ground of

rejection to avoid termination of proceedings (37 CFR § 1.197(c))

as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the application will be remanded to the Examiner . . .
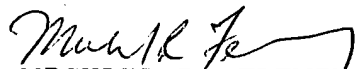
(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record . . .

No time period for taking any subsequent action in

connection with this appeal may be extended under 37 CFR
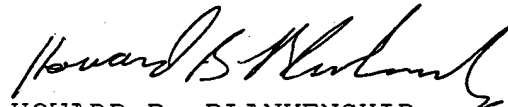
§ 1.136(a).

REVERSED; 1.196(b)

LEE E. BARRETT   )
Administrative Patent Judge   )
)
)
) BOARD OF PATENT
MICHAEL R. FLEMING   )
Administrative Patent Judge   )   APPEALS AND
)
) INTERFERENCES
)
HOWARD B. BLANKENSHIP   )
Administrative Patent Judge   )

MRF:pgc

Appeal No. 2002-0787
Application 08/885,597

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